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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,912	03/05/2002	Richard R. Bott	GC724	9189
7590 11/18/2003 JANET KAISER CASTANEDA GENENCOR INTERNATIONAL, INC. 925 PAGE MILL ROAD PALO ALTO, CA 94304-1013			EXAMINER STEADMAN, DAVID J	
			ART UNIT 1652	PAPER NUMBER

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

16C

**Office Action Summary**

Application No.

10/091,912

Applicant(s)

BOTT ET AL.

Examiner

David J Steadman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Application***

- [1]** Claims 1-29 are pending in the application.
- [2]** It appears claim 10 should depend from claim 9 and not claim 1 and claim 10 has been restricted accordingly. If applicant intends claim 10 to depend from claim 1, applicant should so state and clarify the record.

### ***Election/Restrictions***

- [3]** Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I.** Claims 1-4, 17, 28, and 29, drawn to a cutinase variant having a substitution of Gly at position 59 of SEQ ID NO:2, classified in class 435, subclass 197.
  - II.** Claims 1-3, 5, 24, 28, and 29, drawn to a cutinase variant having a substitution of Thr at position 177 of SEQ ID NO:2, classified in class 435, subclass 197.
  - III.** Claims 1-3, 6, 25, 28, and 29, drawn to a cutinase variant having a substitution of Thr at position 64 of SEQ ID NO:2, classified in class 435, subclass 197.
  - IV.** Claims 1-3, 7, 28, and 29, drawn to a cutinase variant having a substitution of Tyr at position 150 of SEQ ID NO:2, classified in class 435, subclass 197.

- V.** Claims 1-3, 8, 26, 28, and 29, drawn to a cutinase variant having a substitution of Tyr at position 182 of SEQ ID NO:2, classified in class 435, subclass 197.
- VI.** Claims 1-3, 9-10, 12-16, 19, and 27-29, drawn to a cutinase variant having a substitution of Phe at position 180, Ser at position 205 of SEQ ID NO:2, and Ile at position 178, classified in class 435, subclass 197.
- VII.** Claims 1-3, 11, 28, and 29, drawn to a cutinase variant having a substitution of Ala at position 66 of SEQ ID NO:2, classified in class 435, subclass 197.
- VIII.** Claims 1-3, 18, 28, and 29, drawn to a cutinase variant having a substitution of Gly at position 61 of SEQ ID NO:2, classified in class 435, subclass 197.
- IX.** Claims 1-3, 20, 28, and 29, drawn to a cutinase variant having a substitution of Arg at position 20 and Tyr at position 112 of SEQ ID NO:2, classified in class 435, subclass 197.
- X.** Claims 1-3, 21, 28, and 29, drawn to a cutinase variant having a substitution of Ser at position 205 and Phe at position 207 of SEQ ID NO:2, classified in class 435, subclass 197.
- XI.** Claims 1-3, 22, 28, and 29, drawn to a cutinase variant having a substitution of Ser at position 63 of SEQ ID NO:2, classified in class 435, subclass 197.

**XII.** Claims 1-3, 23, 28, and 29, drawn to a cutinase variant having a substitution of Ser at position 85 of SEQ ID NO:2, classified in class 435, subclass 197.

**[4]** The inventions are distinct, each from the other because:

**[5]** Each of the polypeptides of Groups I-XII is structurally distinct and no single polypeptide of Groups I-XII would render any of the others obvious to one of ordinary skill in the art.

**[6]** MPEP § 803 sets forth two criteria for a proper restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed and (B) There must be a serious burden on the examiner. As shown above, each of the inventions of Groups I-XII are independent or distinct, thus satisfying the first criterion for a proper restriction. MPEP § 803 additionally states that a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. Each of the inventions requires a separate patent and non-patent literature search requiring a different text and sequence search for each Group and thus, co-examination of the inventions of Groups I-XII would place a serious burden on the examiner.

### ***Rejoinder***

**[7]** The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise

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include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply

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where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Conclusion***

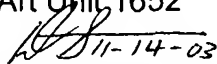
**[8]** Claims 1-3 and 28-29 will be examined only to the extent the claims read on the elected subject matter.

**[9]** Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

**[10]** Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:00 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or informal FAX communications should be directed to (703) 746-5078. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman  
Patent Examiner  
Art Unit 1652

  
**DAVID STEADMAN**  
**PATENT EXAMINER**